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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,220	09/12/2003	Jim E. Rainey	30000064-0053	6821
26263 7590 08/13/2009 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, WILLIS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
RETTA, YIHDEGA				
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3622				
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08/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/661,220

**Applicant(s)**

RAINEY, JIM E.

**Examiner**

Yehdega Retta

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 29 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-13, 22-26 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13, 22-26 and 35-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action is in response to amendment filed May 29, 2009. Applicant amended claims 9, 11-13, 22, 24-26, 35, 37-39. Claims 9-13, 22-26 and 35-39 are pending.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 now recites receiving a search string input by a user; causing a bidding interface to be displayed on at least one display, the bidding interface comprising functionality to allow a bidder to bid for *a search string* and user attribute combination, wherein the user attribute is an attribute of the user who input the search string. The claim also recited receiving at least one bid *for the search string*. It is unclear if the bid is for any search string or for the search string that is input by a user. The claim also recites receiving at least one bid and determining a winner for the at lease one bid. If only one bid is received it is unclear if that bid is determined to be a winner (therefore, there is no step of "determining"). The claim also recites that associating an advertisement for the winner ... so that *when the search string and user attribute combination is input by a user into a search engine*, the advertisement is displayed together with a result *of the search on the display*. As claimed the bidding interface is displayed on a display to allow a **bidder to bid**, the search string is **input by a user** and the search string and user attribute combination is **input by a user** and the advertisement is displayed with a search result **on the display**. Examiner could not determine if the search string ad user attribute is input by the bidder, by the user who input the search string or by other user who is different from the first user and the bidder. Also it could not be determined if the user and the bidder are the same. It is

also unclear who inputs the user attribute and who the user is. As claimed it can be interpreted to mean that the bid can be received from the user who input the search string (who is also a bidder), also it can be interpreted that the advertisement is associated with the search string and is display on the same interface, which allow the bidder to bid.

Examiner would like to point out that the language “**so that when** the search string and user attribute combination **is input by a user into a search engine**, the advertisement is displayed together with a result of search on the display” is intended use of the associating of an advertisement with the search string and user attribute”. Therefore, no patentable weight is given since it has been held that Language (such as statements of intended use or filed of use) that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C).

Claims 22 and 35 also recite similar limitation and are also rejected as stated above.

Claim 9 is recites the limitation "with a result of *the* search". The claim recites receiving a search string input but does not recite search being performed or requested. There is insufficient antecedent basis for this limitation in the claim.

Claims 22 and 35 also recite similar limitation and are also rejected as stated above.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-12, 22-25 and 35-38 are rejected under 35 U.S.C. 102(c) as being clearly anticipated by Mangold et al. (US 2004/0186769 A1).

Regarding claims 9, 10, 12, 22, 23, 25 and 35-38, Mangold teaches *receiving a search string input by a user(advertiser or searcher)*; causing a bidding interface to be displayed on at least one display, the bidding interface comprising functionality to allow a bidder to bid for a search string and user attribute combination; wherein the attribute is an attribute of a user who input the search string; receiving at least one bid for the search string and attribute combination (see [0021]-[0027]) determining a winner of the at least one bid; and associating an advertisement for the winner with the search string and attribute combination so that when the search string and attribute combination is input to a search engine, the advertisement is displayed together with a result of the search; wherein determining the winning bid is based on a monetary amount of the bid (see [0036]-[0039]).

Regarding claims 11, 24 and 37, it recites allowing a bidder to bid and wherein the bidding interface *displays* at least *some of the bids* that have been received for the search engine. However, since the independent claims recite at least one bid, when the bidder enters the bid for the search string and attribute the display would display what is just entered by the bidder.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 26 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold further in view of Official Notice.

Regarding claim 13, 26, 39, Mangold does not teach the user attribute comprises a location in the form of a network address of a computer of the user. However official notice is taken that is old and well known in the art of computer for a location of the user to be in the form of a network address of computer of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the computer's network address in Mangold's search engine in order for the search engine to identify the user geographic location by correlating the network address with the geographic location of the user for the intended purpose of providing targeted ad to the user.

#### ***Response to Arguments***

Applicant's arguments filed May 29, 2009 have been fully considered but they are not persuasive.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ryu (US 6,377,961 B1) teaches submitting an internet protocol address to a web search engine to determine the location of a user inputting search query keyword.

Soulanille (US 6,978,263 B2) teaches displaying current bid amount.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622

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